

REMARKS

In the Office Action, the Examiner rejected each of the pending claims. More specifically, the status of the pending claims is:

- Claim 22 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite, but is otherwise allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim;
- Claims 1, 7-8, 19 and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,409,137 (Bonomelli);
- Claims 1, 4, 6-8, 19 and 21 stand rejected under 35 U.S.C. §102(a) as being anticipated by contents of the application which the Examiner has deemed to be admitted prior art;
- Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bonomelli;
- Claims 2 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Bonomelli and U.S. Patent 3,604,057 (Nixdorff);
- Claims 4-6, 12 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Bonomelli and U.S. Patent 6,131,766 (King); and
- Claims 11, 13-14, 16-18 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Bonomelli, Nixdorff and King.

By this Amendment, claim 1 has been amended, and claims 21 and 22 have been canceled. Applicants believe that no new matter is introduced by the amendment, and submit that support for the amendment may be found throughout the specification as filed. Upon entry of this Amendment, claims 1-8 and 10-20 are pending. For the reasons set forth hereinbelow, Applicants traverse the rejections and respectfully request that the §112, §102 and §103 rejections of the claims be withdrawn.

§112 Rejection

Claim 22

Applicants have herein canceled claim 22. Accordingly, Applicants respectfully request that the §112 rejection associated with claim 22 be withdrawn.

§102(b) Rejections based on Bonomelli

Claims 1, 7-8 and 19

Applicants have herein amended independent claim 1 to incorporate the limitation of canceled claim 22, and have herein canceled claim 21.

Amended claim 1 recites, among other things, “a pressing means for pressing the holder against the measuring vessel, wherein the pressing means comprises a spring”.

Applicants submit that claim 1 is not anticipated by Bonomelli because Bonomelli fails to disclose each and every element of claim 1. *See* MPEP § 2131 (stating that a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference). More particularly, Applicants submit that Bonomelli fails to disclose, among other things, a “pressing means for pressing the holder against the measuring vessel, wherein the pressing means comprises a spring” as recited in claim 1.

As noted by the Examiner in the Office Action, Bonomelli merely discloses that the pressing means is the weight of the holder itself.

Accordingly, Applicants submit that independent claim 1 is not anticipated by Bonomelli because Bonomelli fails to disclose each and every element of claim 1. For similar reasons, Applicants also submit that claims 7-8 and 19, which depend from claim 1, are not anticipated by Bonomelli. Therefore, Applicants request that the §102(b) rejections associated with claims 1, 7-8 and 19 be withdrawn.

§102(a) Rejections Based on Applicants' Specification

Claims 1, 4, 6-8 and 19

The Examiner has deemed the content disclosed at pages 1-2 and FIG. 4 of the

application to be admitted prior art.

Applicants submit that claim 1, as amended, is not anticipated by contents of the application which the Examiner has deemed to be admitted prior art because such contents fail to disclose each and every element of claim 1. *See* MPEP § 2131. More particularly, Applicants submit that the contents of the application which the Examiner has deemed to be admitted prior art fail to disclose, among other things, “a pressing means for pressing the holder against the measuring vessel, wherein the pressing means comprises a spring” as recited in claim 1.

As noted by the Examiner in the Office Action, the content deemed to be admitted prior art merely discloses that the pressing means is the weight of the holder itself.

Accordingly, Applicants submit that independent claim 1 is not anticipated by contents of the application which the Examiner has deemed to be admitted prior art because such content fail to disclose each and every element of claim 1. For similar reasons, Applicants also submit that claims 4, 6-8 and 19, which depend from claim 1, are not anticipated by contents of the application which the Examiner has deemed to be admitted prior art. Therefore, Applicants request that the §102(a) rejections associated with claims 1, 4, 6-8 and 19 be withdrawn.

§103(a) Rejection Based on Bonomelli

Claim 3

Claim 3 depends from independent claim 1. Applicants respectively submit that claim 1 is nonobvious in view of Bonomelli.

In accordance with the analysis stated in *Graham v. John Deere Co.*, a determination of obviousness under § 103 requires (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the

level of ordinary skill in the pertinent art. The question of obviousness must be resolved on the basis of these factual inquiries and any secondary considerations. *See* MPEP § 2141.

Applicants submit that the differences between Bonomelli and the claimed invention are **substantial**, and that when the invention recited in claim 1 is considered as a whole, the invention recited in claim 1 is nonobvious in view of Bonomelli. *See* MPEP § 2141.02 (stating that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious).

The fact that Bonomelli fails to disclose, teach or suggest a “pressing means for pressing the holder against the measuring vessel, wherein the pressing means comprises a **spring**” as recited in claim 1 supports a finding that claim 1 is nonobvious in view of Bonomelli.

Therefore, in view of the foregoing, Applicants submit that the differences between Bonomelli and the claimed invention are **substantial**, and that when the invention recited in claim 1 is considered as a whole, the invention recited in claim 1 is nonobvious in view of Bonomelli. Applicants further submit that claim 3, which depends from claim 1, is also nonobvious in view of Bonomelli. *See* MPEP §2143.03 (stating that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious).

Accordingly, Applicants respectfully request that the §103 rejection associated with claim 3 be withdrawn.

**§103(a) Rejections Based on Bonomelli and Nixdorff**

**Claims 2 and 10**

Claims 2 and 10 depend from independent claim 1. Applicants respectively submit that claims 2 and 10 are nonobvious in view of the combination of Bonomelli and Nixdorff.

In accordance with the analysis stated in *Graham v. John Deere Co.*, a determination of obviousness under § 103 requires (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. The question of obviousness must be resolved on the basis of these factual inquiries and any secondary considerations. *See* MPEP § 2141.

Applicants submit that the differences between the cited references and the claimed invention are substantial, and that when the invention recited in claim 1 is considered as a whole, the invention recited in claim 1 is nonobvious in view of the combination of Bonomelli and Nixdorff. *See* MPEP § 2141.02.

As explained hereinabove, Bonomelli fails to disclose, teach or suggest each and every limitation of claim 1. Applicants submit that Nixdorff fails to remedy the defects of Bonomelli with respect to claim 1. Nixdorff is cited as disclosing “a designated gap kept between the second face and the shutter to prevent shearing of the product”. Even if taken as true, Applicants submit that the combination of Bonomelli and Nixdorff still fails to disclose, teach or suggest a “pressing means for pressing the holder against the measuring vessel, wherein the pressing means comprises a spring” as recited in claim 1, and thus still fails to realize the invention recited in claim 1.

Therefore, in view of the foregoing, Applicants submit that the differences between the claimed invention and the combination of Bonomelli and Nixdorff are substantial, and that when the invention recited in claim 1 is considered as a whole, the invention recited in claim 1 is nonobvious in view of the combination of Bonomelli and Nixdorff. Applicants further submit that claims 2 and 10, which depend from claim 1, are also nonobvious in view of the combination of Bonomelli and Nixdorff. *See* MPEP §2143.03.

Accordingly, Applicants respectfully request that the §103 rejections associated with

claims 2 and 10 be withdrawn.

§103(a) Rejections Based on Bonomelli and King

Claims 4-6, 12 and 15

Claims 4-6, 12 and 15 depend from independent claim 1. Applicants respectively submit that claims 4-6, 12 and 15 are nonobvious in view of the combination of Bonomelli and Nixdorff.

In accordance with the analysis stated in *Graham v. John Deere Co.*, a determination of obviousness under § 103 requires (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. The question of obviousness must be resolved on the basis of these factual inquiries and any secondary considerations. *See* MPEP § 2141.

Applicants submit that the differences between the cited references and the claimed invention are substantial, and that when the invention recited in claim 1 is considered as a whole, the invention recited in claim 1 is nonobvious in view of the combination of Bonomelli and King. *See* MPEP § 2141.02.

As explained hereinabove, Bonomelli fails to disclose, teach or suggest each and every limitation of claim 1. Applicants submit that King fails to remedy the defects of Bonomelli with respect to claim 1. King is cited as disclosing “a dispensing device having sliding parts which are made from acetal resin to prevent wear and oxidation of the parts and to allow for easy cleaning”. Even if taken as true, Applicants submit that the combination of Bonomelli and King still fails to disclose, teach or suggest a “pressing means for pressing the holder against the measuring vessel, wherein the pressing means comprises a spring” as recited in claim 1, and thus still fails to realize the invention recited in claim 1.

Therefore, in view of the foregoing, Applicants submit that the differences between the claimed invention and the combination of Bonomelli and King are substantial, and that when the invention recited in claim 1 is considered as a whole, the invention recited in claim 1 is nonobvious in view of the combination of Bonomelli and King. Applicants further submit that claims 4-6, 12 and 15, which depend from claim 1, are also nonobvious in view of the combination of Bonomelli and King. *See* MPEP §2143.03.

Accordingly, Applicants respectfully request that the §103 rejections associated with claims 4-6, 12 and 15 be withdrawn.

§103(a) Rejections Based on Bonomelli, Nixdorff and King

Claims 11, 13-14, 16-18 and 20

Claims 11, 13-14, 16-18 and 20 depend from independent claim 1. Applicants respectively submit that claims 11, 13-14, 16-18 and 20 are nonobvious in view of the combination of Bonomelli, Nixdorff and King.

In accordance with the analysis stated in *Graham v. John Deere Co.*, a determination of obviousness under § 103 requires (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. The question of obviousness must be resolved on the basis of these factual inquiries and any secondary considerations. *See* MPEP § 2141.

Applicants submit that the differences between the cited references and the claimed invention are substantial, and that when the invention recited in claim 1 is considered as a whole, the invention recited in claim 1 is nonobvious in view of the combination of Bonomelli, Nixdorff and King. *See* MPEP § 2141.02.

The fact that neither Bonomelli, Nixdorff, nor King, either alone or in combination, discloses, teaches or suggests a “pressing means for pressing the holder against the measuring vessel, wherein the pressing means comprises a spring” as recited in claim 1 supports a finding that claim 1 is nonobvious in view of the combination of Bonomelli, Nixdorff and King.

Therefore, in view of the foregoing, Applicants submit that the differences between the claimed invention and the combination of Bonomelli, Nixdorff and King are substantial, and that when the invention recited in claim 1 is considered as a whole, the invention recited in claim 1 is nonobvious in view of the combination of Bonomelli, Nixdorff and King. Applicants further submit that claims 11, 13-14, 16-18 and 20, which depend from claim 1, are also nonobvious in view of the combination of Bonomelli, Nixdorff and King. See MPEP §2143.03.

Accordingly, Applicants respectfully request that the §103 rejections associated with claims 11, 13-14, 16-18 and 20 be withdrawn.



CONCLUSION

Applicants respectfully request a Notice of Allowance for the pending claims in this application. If the Examiner believes that personal communication will expedite the prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Muha", written over a horizontal line.

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